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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/886,773	06/21/2001	Guy W. Bemis	VPI94-04DIV5	6928
1473	7590	09/19/2006		
FISH & NEAVE IP GROUP ROPES & GRAY LLP 1251 AVENUE OF THE AMERICAS FL C3 NEW YORK, NY 10020-1105			EXAMINER LUKTON, DAVID	
			ART UNIT 1654	PAPER NUMBER

DATE MAILED: 09/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/886,773

Applicant(s)

BEMIS ET AL.

Examiner

David Lukton

Art Unit

1654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 102-104, 125 and 129-218 is/are pending in the application.
- 4a) Of the above claim(s) 135-218 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 102-104, 125 and 129-134 is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Pursuant to the response filed 12/16/03, claims 76, 105-107, 118, 126-128 have been cancelled, and claims 129-134 added. Claims 102-104, 125, 129-134 were pending at that point.

A first supplemental amendment was filed on 3/4/04 which added claims 135-141. Claims 102-104, 125, 129-141 were pending at that point. A second supplemental amendment was filed on 3/11/04 which added claims 142-218. Claims 102-104, 125, 129-218 were pending at that point and remain pending at this time.



Claims 102-104, 125, 129-134 are now allowable. Claims 135-218, however, are drawn to a non-elected invention. What is required in response to this Office action is cancellation of the non-elected claims (claims 135-218) or other course of action as deemed appropriate to achieve compliance with the restriction requirement.

Applicants have argued that one or more of claims 135-218 were allowed by the examiner who issued the following patents: 6528506, 6531467, 6610683 and 6693096. Applicants have implied, though not stated, that the examiner of the instant application is obligated to either re-examine the claims of the four cited patents, or else to allow them for a second time (subject to relevant terminal disclaimers). The examiner of the instant application contends that he bears no obligation to reexamine an application that has been previously been examined by another examiner, and that he bears no obligation to assume that all applicable rejections have been made. For example, claim 135

of the instant application is the same as claim 1 of USP 6,528,506. The presumption of validity is indeed conferred upon this claim. However, the “presumption of validity” does not mean that a suitably authorized legal body cannot find otherwise. If this claim were to be examined by the examiner of the instant application, the first task would be to determine whether or not it is really true that inhibitors of IL-1 *beta* converting enzyme were indeed unknown prior to June 17, 1994. Second, an inquiry would have to be conducted to determine whether the skilled artisan could reliably predict success in the treatment and prevention of inflammatory disease, using inhibitors of IL-1 *beta* converting enzyme. Further, a new search for prior art would have to be conducted for all of the other subject matter encompassed by claims 135-218.

The subject matter encompassed by claims 135-218 is independent and distinct from that which has been elected; the fact that another examiner may have abstained from imposing rejections against one or more of these claims does not obligate the examiner of the instant application to re-examine those claims.

. . . .

Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle* [1935 C.D. 11, 453 O.G. 213].

A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.



Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lukton whose telephone number is 571-272-0952. The examiner can normally be reached Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang, can be reached at (571)272-0562. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.

A handwritten signature in black ink, appearing to read 'D. Lukton', written in a cursive style.

DAVID LUKTON, PH.D.  
PRIMARY EXAMINER